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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,955	02/16/2001	Martina Wicher	421 P 037	5781
26568	7590	03/29/2005	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD			KRUER, KEVIN R	
SUITE 2850			ART UNIT	PAPER NUMBER
200 WEST ADAMS STREET			1773	
CHICAGO, IL 60606				

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,955

Applicant(s)

WICHER ET AL.

Examiner

Kevin R Kruer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10,11,15-18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on January 6, 2005 has been entered.

Election/Restrictions

2. Claims 12-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 09/11/2002.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 4, 15, 16, 18, 21, and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Nemoto et al (US 6,783,817).

Nemoto teaches an ink jet recording sheet including a substrate sheet having a base paper sheet and at least a front polyolefin laminate layer, and an ink receiving layer formed on the front polyolefin laminate layer. The polyolefin layer comprises a center-line mean roughness of 0.1-1.0um (col 8, lines 58+) and comprise a white coloring pigment such as calcium carbonate, with an average particle size of about 1.0um or less, and preferably having an average particle size of 0.5um or less (col 11, lines 59+). The polyolefin layer may comprise two or more layers each comprising the same composition (col 13, lines 40+). In such an embodiment, the polyolefin layer adjacent to the paper layer is understood to read on the claimed pigment layer and the layer adjacent to the ink-receiving layer is herein understood to read on the claimed polyolefin layer. The polyolefin coating is applied in amounts of 10-30g/m² (col 13, lines 30+).

With respect to the claimed particle distribution, when the composition comprises particles with an average particle size of 0.5um or less, at least 5% of the particles will inherently have a particle size of 0.35um to 0.8um. Said "at least 5%" of particles is

herein understood to read on the claimed "pigment having particles with a narrow grain distribution."

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 8, 11, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemoto et al (US 6,783,817), as applied to claims 1, 2, 4, 15, 16, 18, 21, and 23-25 above, and further in view of Viratanen (US 6,143,064).

Nemoto is relied upon as above, but does not teach that the white pigment should comprise surface modified pigment. However, Viratanen teaches a pigment particle comprising a pigment particle that is coated with particles of precipitated calcium carbonate (abstract). The precipitated calcium carbonate is platelet shaped (see electron micrograph figures). Said particles have excellent brightness (abstract) and are useful in paper coatings. Therefore, it would have been obvious to one of ordinary skill in the art to utilize the surface modified particles taught in Naydowski as the pigment taught in Nemoto. The motivation for doing so would have been to improve the brightness of the paper.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nemoto et al (US 6,783,817), as applied to claims 1, 2, 4, 15, 16, 18, 21, and 23-25 above.

Nemoto teaches the use of a paper substrate but does not teach the claimed density. However, it is known in the art that the cost of a paper substrate can be reduced by reducing the paper's density. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the density of the paper layer taught in Nemoto in order to reduce processing costs.

8. Claims 3, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nemoto et al (US 6,783,817), as applied to claims 1, 2, 4, 15, 16, 18, 21, and 23-25 above, and further in view of Canton (US 5,078,793).

Nemoto is relied upon as above, but does not teach that kaolin clay may be utilized as the white pigment. However, Canton teaches that kaolin clays have been used as white pigments in papers (col 1, lines 13+). Therefore, it would have been obvious to utilize kaolin clay as the white pigment taught in Nemoto. The motivation for doing so is that kaolin clay has traditionally been used in the art as a white pigment.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer
Patent Examiner-Art Unit 1773